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09/684,866	10/06/2000	David Allison Bennett	PSTM0038/MRK/STM	2836

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EXAMINER
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COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 03/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/684,866

Applicant(s)

BENNETT ET AL.

Examiner

Edward R. Cosimano

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 9/14/04 & 11/3/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/6/00 & 9/14/04 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/22/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

1. Applicant should note the changes to patent practice and procedure:
  - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;
  - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and
  - C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.
2. Applicant's claim for the benefit of an earlier filing data under 35 U.S.C. § 119(e) is acknowledged.
3. The proposed drawing correction filed 14 September 2004 has been approved.
4. The drawings filed 06 October 2000 and amended 14 September 2004 are objected to because:
  - A) the following errors have been noted in the drawings:
    - (1) it is noted that fig. "65b" which was renumbered as "65" in the drawing amendment filed 14 September 2004 should be labeled as -FIG. 65B--, note paragraph numbers 75 & 394.
- 4.1 Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The disclosure as amended on 14 September 2004 is objected to because of the following informalities:

A) as required by 37 CFR § 1.84(p(5)) and 37 CFR § 1.121(e) the specification lacks an explicit reference to the nature of:

(1) how the program proceeds after box(es):

(a) 3026 of fig. 36C if the inquiry is "NO" as this figure is described in the paragraph number 291; and

(b) 1163, 1168, 1169, 1172, 1175, 1180, 1184, 1187 & 1190 of figs. 39B & 39C if the inquiry is "NO" as this figure is described in the paragraphs numbered 300 through 326.

In this regard, it is noted that merely mentioning either a feature or a number with out mentioning the device or operation or number or feature relies on the drawing to provide support for the disclosure and not to aid in the understanding of the invention, as is the purpose of the drawings (37 CFR § 1.81(a,b)).

B) the following errors have been noted in the specification:

(1) as can be seen in figs. 33A & 33B, in paragraph number 231, at line 3 as amended 14 September 2004, "252-2, 252-2" should be -252-1, 252-2--; and

(2) the description of figs. 36C & 36D in the paragraph number 291 does not correspond to what is depicted in these figs. in regard to step 3026, since at one point the "YES" and "NO" legends appear to be mislabeled, note lines 2-3 of this paragraph and lines 8-10 of this paragraph.

Appropriate correction is required.

6. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

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7. Claims 1-10, 12-49 & 51-53 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7.1 In regard to claims 1-10, 12-49 & 51-53, although one of ordinary skill at the time of the invention would know how to accomplish each of the individual recited actions/functions from the language of these claims, since, there is no clear and definite interconnection between one or more of the recited limitations of these claims, one of ordinary skill could not determine from the language of these claims whether or not they are in fact making and/or using the claimed invention. In this regard it is noted that from the language of these claims it is vague, indefinite and unclear:

A) in regard to claims 1-3, 23 & 26 and why and how the recited system/method/product would “poll respective carrier systems via a global communications network for tracking information”, since the invention as recite in these claims does not:

(1) generate a tracking identifier for each of the shipped parcels, so that the parcel may be identified and properly tracked throughout the delivery process by the carrier system;

(2) sense/detect/obtain the tracking identifier during the delivery process so as to generate tracking information; and

(3) hold/store any type of tracking information obtained by the carrier systems regarding the shipped parcels throughout the delivery process so that tracking information would be available at the carrier system when the carrier system is polled for tracking information.

B) in regard to claims 4-8, and how and why the “first user” would select/designate either:

(1) a “subset of carriers” for display to a “second user” (claim 4); or

(2) a customized “calculation and display” of itemized charges to a “second user” (claim 5); or

(3) the display preferences for displaying “itemized shipping charges” to a “second user” (claim 6); or

(4) a “subset of payment options” for display to a “second user” (claims 7-8), where claim 8 further stores the designations; or

since the invention as recited in these claims does not:

(1) receive the designation/selection of the “first user” so that the designation/selection of the “first user” may be used as recited in these claims;

(2) receive an indication from the “second user” of a designation/selection from the displayed information so that, for example, the total “itemized charges” may be determined/calculated and displayed;

(3) recite a relationship between that “first user” and the “second user” that would make designation/selection of the “first user” meaningful to the “second user”; and

(4) require that either the selection/designation by either the “first” or “second” user be used in any manner.

C) in regard to claim 9, and how the “first user’s option preferences” maybe used as recited in this claim, since the invention as recited in this claim has not set forth, designated or received the preferences of the first user so that they may be used as recited in this claim.

D) in regard to claim 9, and why the “linkable address” is created on the server computer, since the invention as recited in this claim does not use this information.

E) in regard to claim 10, and why and how the “hypertext link” is presented to “a second user”, since the invention as recited in this claim does not create a hypertext link because the invention merely uses data from a “first user” that is unrelated to the “second user” to populate a “hypertext link template” and hence the populated hypertext link may not be relevant to the second user.

F) in regard to claim 12, and why the data is collected from the “first user” and the “second user”, since the invention as recited in this claim does not require that the collected data be used by anyone or anything.

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G) in regard to claims 13-14, and why the “unique tracking number” is generated (claim 13), a relationship identified and information stored (claim 14), since the invention as recited in these claims does not require that either the store information or the tracking number be used by anyone or anything.

H) in regard to claims 15 & 23 and why and how the recited system/method/product would “obtain shipping status information from respective carrier systems” in response to a “tracking number”, since the invention as recite in this claim does not:

- (1) generate a tracking identifier for each of the shipped parcels, so that the parcel may be identified and properly tracked throughout the delivery process by the carrier system;

- (2) sense/detect/obtain the tracking identifier during the delivery process so as to generate tracking information; and

- (3) hold/store any type of tracking information obtained by the carrier systems regarding the shipped parcels throughout the delivery process so that tracking information would be available at the carrier system when the carrier system is polled for tracking information.

I) in regard to claims 16-17 & 20, and why the first user is notified of an action by a second user, such as not completing a transaction, since the invention as recited in these claims has not required the first and second user to enter into any transaction so that the second user may refuse to complete the transaction.

J) in regard to claims 18-19, and why an entry in to the “shipping log” of a first user is generated, since the selection of shipping an item is made by a “second user” that is unrelated to the “first user”.

K) in regard to claim 19, and how an comparison display of the rates of different carriers may be displayed, since the invention as recited in these claims has not created, generated, received, etc., this information so that it may be displayed and selected.

L) in regard to claim 21, and why the number is selected, since the invention as recited in this claim does not require the selected number to be used by anyone or anything.

M) in regard to claims 22-23, and how the system may respond to the tracking request with tracking information, since the invention as recited in this claim does not require that tracking information be collection/obtained so that the system may respond with tracking information in response to a tracking request.

N) in regard to claim 24 and why a tracking request is recognized, since the invention as recited in this claim does not use this information.

O) in regard to claim 25 and why the requests for shipping status information are generated, since the invention as recited in this claim does not retrieve status information nor is the status information ever used by anyone or anything.

P) in regard to claims 27-29 and why the various different types of rules are applied based on an user's request, since the invention as recited in this claim does not require the results to be used by anyone or anything.

Q) in regard to claim 30, and why the recited data is collected, since the invention as recited in this claim does not use the collected data.

R) in regard to claims 31-32, and why is the weight as measured by a user's scale and communicated to a remote location recognized, since invention as recited in these claims does not use the recognized transmitted weight.

S) in regard to claim 33 and how the recited information may be displayed on the user's display, since the invention as recited in this claim does not generate, create, receive or obtain the recited information so that it may be displayed.

T) in regard to claims 34-49 & 51-53, and how either the "shipping rate" may be determined (claims 34 & 42), or the "delivery schedule" may be determined (claims 35, 42 & 51), or "delivery notification" may be given (claims 36-37) or a "delivery notification charge" may be determined (claims 37-38) or the availability of a "delivery service option" may be determined (claims 39-40) or a "delivery option charge" may be determined (claim 41), or a the displayed information/data may be renewed/updated



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(claim 43), or a display of information may be generated by filling in the display (claims 44-45), or determine if "billing rules" apply to "billing option preference" or weight (claims 46-49), or a "shipping label display" may be generated (claims 52-53), since the invention as recited in these claims does not receive, set forth or obtain the information that one of ordinary skill would have recognized as necessary for determining either the "shipping rate" (claims 34 & 42), or the "delivery schedule" (claims 35 & 42), or at least to whom to provide a "delivery notification" (claim 36) or the rating system required to determine a notification charge (claims 37-38) or determining if a "delivery service option" is available for a carrier (claims 39-40), or the rating system required to determine a delivery option charge (claim 41), or determine if an input has changed so that the information/data maybe updated to reflect any changes (claim 43), or where the data may be put to fill/created a display (claims 44-45), or what "billing rules" of a carrier are applicable to a "billing option" or weight (claims 46-49), or the information required to create a dimensionally accurate shipping label (claims 52-53).

7.2 For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

8. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

8.1 Claims 1-21 & 23-53 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

8.1.1 The instant claims recite a system, (claims 1, 4-21, 23-43, 46-53), and a method comprising a series of steps to be performed on a computer, (claim 2), and a manufacture comprising program code to be executed by a computer, (claims 3, 44 & 45), which have a disclosed practical application in the technological or useful arts. Further, the instant claims do not merely define either a computer program, a data structure, non-functional descriptive material, (i.e. mere data) or a natural phenomenon.

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8.1.2 In regard to claims 1-21 & 23-53 the invention as set forth in these claims merely describes:

A) in regard to claims 1-3, 15 & 26, a system/method/product that is collects data but does not use the collected data for any purpose.

B) in regard to claims 4-8, a system that displays to a second user various types of information that has been designated by a first user, where the displayed information is not used by anyone or anything. Claim 8 further stored the designations.

C) in regard to claim 9, a system that creates a "linkable address" and collects "option preference" data, where the "linkable address" and the "option preferences" are not used by anyone or anything.

D) in regard to claim 10, a system that populates a template with received data and then does not require that the populated template be used by anyone or anything.

E) in regard to claim 11, a system that prepares information in response to a request based on received information with out requiring that the prepared information be used by anyone or anything.

F) in regard to claim 12, a system that merely collects information/data with out requiring that the collected information/data be used by anyone or anything.

G) in regard to claim 13, a system that merely generates a tracking number with out requiring that the generated tracking number be used by anyone or anything.

H) in regard to claim 14, a system that merely generates a tracking number and then stores the tracking number with other data with out requiring that the generated and stored number/information be used by anyone or anything.

I) in regard to claim 16-17 & 20, a systems that communicated a notification about a second user to a first user about a transaction that has not been entered in to by the first and second users.

J) in regard to claims 18-19, a system that merely generates a information that is stored and/or selected with out requiring that the generated, selected and/or stored number/information be used by anyone or anything.

K) in regard to claim 21, a system for the selection of information from a list with out requiring that the selected information be used by anyone or anything.

L) in regard to claim 23, a system for responding to a request with information which has not bee obtained.

M) in regard to claim 24 a system for recognizing a tracking number, with out requiring that the recognized tracking request be used by anyone or anything.

N) in regard to claim 25 a system for requesting status information, with out requiring that the status information be retrieved or be used by anyone or anything.

O) in regard to claims 27-29, a system to apply various sets of rules/specification based on an user's request, with out requiring the results to be used by anyone or anything.

P) in regard to claim 30, a system for collecting data/information that as recited is not used by anything or anyone.

Q) in regard to claims 31-32, a system for recognizing the weight as transmitted from a remote location, since this information is not used by anyone or anything.

R) in regard to claim 33, 36, collect data/information based on a request and then display the collected data, where the displayed data as recited is not used by anything or anyone.

S) in regard to claims 34-53, calculate/determine/update data/information based on a request, where the calculated/determined/updated information/data data as recited is not used by anything or anyone.

However, the process/system/manufacture as recited in these claims does not require the result of either the claim as a whole or the manipulations of data as recited in these claims be applied in any manner so as to be tangibly used in a concrete manner and hence to produce a useful concrete and tangible result, that is a concrete and tangible application with in the technological or useful arts.

8.1.3 It is further noted that applicant has not recited in these claims a specific process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, which is either:

- A) altered or changed or modified by the invention recited in claims; or
- B) utilizes the result of the invention recited in these claims; or
- C) is operated or controlled by the result of the invention recited in these claims.

8.1.4 It is further noted in regard to claims 1-21 & 23-53, that as claimed applicant has not claimed:

A) pre computer processing, since the claims fail to recited that the data, which originates from an unknown source, is manipulated or transformed/changed before it is processed by the claimed invention; or

B) post computer processing, since the claims fail to recited that the data which represents the result of the claimed manipulation, is neither manipulated nor used nor changed by any device after it has been processed by the claimed invention; or

C) a practical use of the claimed invention by any physical system or device or method outside of the claimed invention other than a statement of the intended use of the claimed invention; or

D) process steps or physical acts/operations by the claimed invention that would affect the internal operation of a computer/machine as were found to be statutory in either In re McIlroy 170 USPQ 31 (CCPA, 1971) or In re Waldbaum 173 USPQ 430 (CCPA, 1972); or

E) process steps or physical acts/operations by the claimed invention that would be considered as going beyond the manipulation of “abstract ideas” as were found to be non-statutory in In re Warmerdam 31 USPQ2d 1754 (CAFC, 1994); or

F) a concrete and tangible practical application of either:

(1) the invention as a whole; or

(2) the final results of the manipulations/actions with in the technological or useful arts;

note In re Sarkar 200 USPQ 132 (CCPA, 1978) where the process step of “constructing said obstruction within the actual open channel at the specified adjusted location indicated by the mathematical model” was held to be so tenuous connected to the remaining process steps as to not be a process with in the scope of 35 U.S.C. § 101.

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Hence, the invention of claims 1-21 & 23-53 is merely directed to an hypothetical mental exercise that manipulates an abstract idea of collecting data/information and manipulating the collected data/information with requiring the results of the collecting and/or manipulation to be used and hence is with out a claimed concrete and tangible practical application of the abstract idea, (note In re Beauregard 35 USPQ2d 1383 (CAFC 1995) and the associated claims of U.S. Patent 5,710,578; and State Street Bank & Trust Co. v. Signature Financial Group Inc. 47 USPQ2d 1596 (CAFC 1998)).

8.1.5 It is further noted that the type/nature of either the data or the calculated numbers does not affect the operation of the claimed invention and hence are considered to be non function descriptive material, (note In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983)).

8.1.6 In practical terms, claims define nonstatutory processes if they:

A) consist solely of mathematical operations without some claimed practical application (i.e., executing a “mathematical algorithm”); or

B) simply manipulate abstract ideas, e.g., a bid (Schrader, 22 F.3d at 293-94, 30 USPQ2d at 1458-59) or a bubble hierarchy (Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759),

without some claimed practical application of the mathematics or abstract idea.

8.1.7 In view of the above analysis claims 1-21 & 23-53, as a whole, are directed to an hypothetical mental exercise that merely manipulates mathematics or an abstract idea without a claimed concrete and tangible practical application of the mathematics or abstract idea, and hence are directed to non-statutory subject matter.

8.2 Claims 3, 44 & 45 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

8.2.1 The instant claims recite a system/device/manufacture, (claims 3, 44 & 45), which has a disclosed practical application in the technological or useful arts, and which does not merely define either a computer program, a data structure, non-functional descriptive material, (i.e. mere data) or a natural phenomenon. Hence, the instant claims merely define

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device/manufacture that contains a data structure comprising series of steps or acts or functions or operations that as claimed could be but are not necessarily to be performed by a computer.

8.2.2 It is further noted that applicant has not recited a specific machine since the steps or acts or functions or operations recited in the claim are merely to illustrate the steps or acts or functions or operations of the instant invention since these steps or acts or functions or operations as claimed are not in fact required to be implemented by a processor/computer. Hence, applicant envisions the invention as recited in claim claims 3, 44 & 45 as a disembodied storage device, i.e. memory, that stores a computer program as a non-functional data structure. Such a disembodied storage device is not a specific machine because:

A) it is not associated with a computer in such a way as to cause the computer to operate in a specific manner, (note In re Beauregard 35 USPQ2d 1383 (CAFC 1995) and the associated claims of U.S. Patent 5,710,578); and

B) a memory device alone can not perform the functions recited within the claims.

Therefore, the recited disembodied storage device, which itself can not perform the functions recited within the claims as the invention, is inoperative and lacks utility for the purpose of the invention.

8.2.3 In view of the above, the invention recited in claims 3, 44 & 45, merely describes an abstract idea of a disembodied storage device, i.e. memory, that stores a computer program as a non-functional data structure, since a disembodied storage device by itself can not produce a concrete and tangible result by performing the functions recited within the claims as the invention (State Street Bank & Trust Co. v. Signature Financial Group Inc. 47 USPQ2d 1596 (CAFC 1998)). Hence, claims 3, 44 & 45 do not have a claimed practical application, since the disembodied storage device is inoperative and therefore lacks utility for the purpose of the invention.

8.2.4 Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the

descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are:

- a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium;
- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or
- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

8.2.5 Hence, claims 3, 44 & 45 directed to non-statutory subject matter.

8.3 Claims 1-10, 12-49 & 51-53 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

8.3.1 As set forth by the Court in:

A) In re Musgrave 167 USPQ 280 at 289-290 (CCPA 1970), “We cannot agree with the Board that these claims (all the steps of which can be carried out by the disclosed apparatus) are directed to non-statutory processes merely because some or all of the steps therein can also be carried out in or with the aid of the human mind or because it may be necessary for one performing the process to think. All that is necessary, in our view, to make a sequence of operational steps a statutory “process” within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of “useful arts.” Cons. Art. 1, sec. 8.”, {emphasis added}; and

B) In re Sarkar 100 USPQ 132 @ 136-137 (CCPA 1978), echoing the Board of Appeals stated in regard to claim 14 “14. A method of locating an obstruction in an open channel to affect flow in a predetermined manner comprising:

a) obtaining the dimensions of said obstruction which affect the parameters of flow;

b) constructing a mathematical model of at least that portion of the open channel in which said obstruction is to be located in accordance with the method of claim 1 using those dimensions obtained in step (a) above;

c) adjusting the location of said obstruction within said mathematical model until the desired effect upon flow is obtained in said model; and thereafter

d) constructing said obstruction within the actual open channel at the specified adjusted location indicated by the mathematical model.”;

and “Concerning claims 14-39 and the significance of “post-solution activity,” like building a bridge or dam, the board concluded: While it is true that the final step in each of these claims makes reference to the mathematical result achieved by performing the prior recited steps, we consider the connection to be so tenuous that the several steps recited in each claim when considered as a whole do not constitute a proper method under the statute.”, {emphasis added}.

8.3.2 Further, it is noted in regard to claims 14-39 of Sarkar, although step (d) of claim 14 of Sarkar references the result of step (c) of claim 14 of Sarkar it is clear from the language of step (c) of claim 14 of Sarkar that multiple adjustments to the location of the obstruction are required to be made until a location with the desired effect has been determined. Hence, the reference to constructing the obstruction at the “specified adjusted location” in step (d) of claim 14 of Sarkar is vague, indefinite and unclear in regard to which one of the possible multiple adjusted locations of the obstruction that were used during step (c) of claim 14 of Sarkar would be used when constructing the obstruction as required by step (d) of Sarkar. Therefore, without a clear connection between step (d) of Sarkar and the remaining steps of claim 14 of Sarkar, the Board of Appeals and the Court held that these claims were not a process within the meaning of process as used in 35 U.S.C. § 101 and hence were directed to non statutory subject matter.



8.3.3 As can be seen from claims 1, 2, 4-10, 12-43, 46-49 & 51-53, these claims are directed to a series of devices for performing various functions or steps/actions/functions, which as set forth above in regard to the rejection of claims 1, 2, 4-10, 12-43, 46-49 & 51-53 under 35 U.S.C. § 112 2<sup>nd</sup> paragraph, are not clearly and definitely interconnected to one another and therefore do not provide an operative useful machine/system or method/process with in the meaning of machine or process as used in 35 U.S.C. § 101.

8.3.4 Further on regard to the computer useable/readable medium of claims 3, 44 & 45, the recited limitations are not clearly and definitely interconnected to one another and a device to execute the program code/instructions on the media so as to provide a useful operative and useful manufacture with in the meaning of machine or process as used in 35 U.S.C. § 101.

8.4 Claims 1-53 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter, since:

A) in regard to claims 1-10, 12-49 & 51-53, these claims fail to comply with the "requirements this title, namely 35 U.S.C. § 112 2<sup>nd</sup> paragraph as set forth above.

B) in regard to claims 1-5, 11-34, 36-47, 49 & 50, these claims fail to comply with the "requirements this title, namely 35 U.S.C. § 102 as set forth below.

C) in regard to claims 6-10, 35, 48 & 51-53, these claims fail to comply with the "requirements this title, namely 35 U.S.C. § 103 as set forth below.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the

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applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9.1 Claims 1-5, 11-34, 36-47, 49 & 50 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by either PRNewswire release from Tulsa Oklahoma (herein after TULSA) or Thiel (5,699,258).

9.2 Claims 1-5, 11-34, 36-47, 49 & 50 are rejected under 35 U.S.C. § 102(a) as being clearly anticipated by PRNewswire release from Tempe Arizona (herein after TEMPE).

9.3 Claims 1-5, 11-34, 36-47, 49 & 50 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Barton (2002/0022983).

9.4 In regard to claims 1-5, 11-34, 36-47, 49 & 50, either TULSA or Thiel ('258) or TEMPE or Barton ('983) discloses a computerized shipping system that comprises cooperation among a number of properly programmed server and client systems. When these systems cooperate, the shipping systems accept rating related information, for example, size, weight, destination, special services, etc., from users and then return to the user from the server the shipping rate for a number of different carriers using a communications network to exchange the information. The determined rate for each of the carriers, that will support the specification in the user's request, is then provided/displayed to the user in a convenient format so that the user may select the carrier that best suites the needs of the user.

9.4.1 Where the shipping system of either TULSA or TEMPE or Barton ('983) is an internet based shipping system.

9.4.2 And where the shipping systems of either TULSA or Thiel ('258) permits the user track the item being shipped for it's origin to it's destination. Since, this tracking feature would inherently indicate the fact that the recipient has either accepted or refused delivery of the shipped item, and if the shipped item was purchased and the recipient refused to accept

delivery, then such an occurrence indicate that recipient has refused to complete the purchase of the item being shipped.

9.4.3 Further, since:

A) the internet is a communications network as is the wireless network of Thiel ('258), and

B) the claims fail to recite sufficient structure so as to distinguish a particular type of communications network, one of ordinary skill at the time the invention would recognize the two separate types of networks as functionally equivalent. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are:

- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or

- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

10. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

10.1 Claims 6-8 & 48 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either PRNewswire release from Tulsa Oklahoma (herein after TULSA) or Thiel (5,699,258) or PRNewswire release from Tempe Arizona (herein after TEMPE) or Barton (2002/0022983) as applied to claims 1-5, 11-34, 36-47, 49 & 50 and further in view of an obvious modification for customer service.

10.1.1 In regard to the use of user preferences of claims 6-8 & 48, although neither TULSA nor Thiel ('258) nor TEMPE nor Barton ('983) disclose using user preferences, it would have been obvious to one of ordinary skill at the time the invention was made that the shipping systems of either TULSA or Thiel ('258) or TEMPE or Barton ('983) could be modified to record the user's preferences for shipping services, since it would be good customer service to not require a frequent user to constant re-enter shipping/payment information each time the user used the shipping system.

10.2 Claims 35 & 51 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either PRNewswire release from Tulsa Oklahoma (herein after TULSA) or Thiel (5,699,258) or PRNewswire release from Tempe Arizona (herein after TEMPE) or Barton (2002/0022983) as applied to claims 1-8, 11-34 & 36-50 and further in view of an obvious modification in view of the need of the customer.

10.2.1 In regard to claims 35 & 51 neither TULSA nor Thiel ('258) nor TEMPE nor Barton ('983) disclose comparing the delivery times a number of carriers. However, it is respectfully noted that:

A) the user of the systems of either TULSA or Thiel ('258) or TEMPE or Barton ('983) may be more concerned with when the package may arrive at it's destination due to some time related requirements rather than spending the least amount of money to have the package shipped; and

B) most carriers offer over night or next day or two days services.

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made that the user of the systems of either TULSA or Thiel ('258) or TEMPE or Barton ('983) could also considered the delivery times when selecting a carrier.

10.3 Claims 52 & 53 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either PRNewswire release from Tulsa Oklahoma (herein after TULSA) or Thiel (5,699,258) or PRNewswire release from Tempe Arizona (herein after TEMPE) or Barton (2002/0022983) as applied to claims 1-8 & 11-51 and further in view of an obvious modification in view of the need of the customer.

10.3.1 In regard to the printing of a shipping label of claims 52 & 53, although neither TULSA nor Thiel ('258) nor TEMPE nor Barton ('983) disclose using printing a shipping label, it would have been obvious to one of ordinary skill at the time the invention was made that the shipping systems of either TULSA or Thiel ('258) or TEMPE or Barton ('983) could be modified to print shipping labels, since most carriers require the user to pre-address the item before the carrier accepts the item for shipping.

10.4 Claims 9 & 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either PRNewswire release from Tulsa Oklahoma (herein after TULSA) or PRNewswire release from Tempe Arizona (herein after TEMPE) or Barton (2002/0022983) as applied to claims 1-8 & 11-53 and further in view of an obvious modification in view of the system's operation.

10.4.1 In regard to the linking of claims 9 & 10, although neither TULSA nor TEMPE nor Barton ('983) disclose using hyperlinks, it would have been obvious to one of ordinary skill at the time the invention was made that the internet based shipping systems of either TULSA or TEMPE or Barton ('983) would use hyper links to permit the user to move from one location to another location or from one web page to another as is common in internet based systems.

11. In regard to the Information Disclosure Statements filed December 10, 2001 and December 18, 2001, it is noted that the appendix of application serial number 09/820,377 as well as the 15 U.S. Patent Applications listed were not publicly known before the filing date of the instant application, that is October 06, 2000, therefore these applications have been considered only for the purposes of double patenting.

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12. Response to applicant's arguments.

12.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

12.2 As per the objections to the drawings and specification, it is noted that:

A) applicant failed to address point (5)(B)(2) above;

B) applicant's arguments in regard to points (5)(A)(1,2) above are non persuasive, since applicant may not rely on the drawings to provide descriptive support for the operation of the invention.

C) in regard to point (4)(A) and (5)(B)(1), these objection were caused by applicant's amendments.

Hence, applicant's arguments are non persuasive.

12.2 As per the 35 U.S.C. § 101 rejection, since the claims fail to contain an explicit recitation that the instructions are executed to control the operation of the recited devices, applicant's arguments are non persuasive.

12.3 As per the 35 U.S.C. § 102 & 35 U.S.C. § 102 rejections, since the systems of the prior art are internet based systems, one of ordinary skill would recognize that these systems are client/server based systems, and hence applicant's arguments are non persuasive.

13. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783 (after 13 April 2005 (571) 272-6802). The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702 (after 13 April 2005 (571) 272-6812). Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

14.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

14.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

14.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

03/02/05

  
Edward R. Cosimano  
Primary Examiner A.U. 3629